

Application No. 09/899,358
Filed: July 5, 2001
TC Art Unit: 2633
Confirmation No.: 2146

REMARKS

The instant Remarks are filed in response to the official action dated May 19, 2004. Reconsideration is respectfully requested.

The status of the claims is as follows:

Claims 1-11 are currently pending.

Claims 1-11 are subject to restriction and/or election requirement.

ELECTION

The Applicants elect claims 1-2 and 8-11 drawn to a method of assigning a set of predetermined lightpath connections in a WDM optical ring communications network, and a method of analyzing predetermined lightpath arcs in a WDM optical ring network (species 1, Fig. 6a). The Applicants respectfully submit that the above election is made with traverse.

TRAVERSAL OF RESTRICTION REQUIREMENT

The official action indicates that the claims listed in the above-referenced application are separated into the following species: Species 1, Fig. 6a, and Species 2, Fig. 6b. The official action further indicates that an election of a single disclosed

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WEINGARTEN, SCHURGIN,
GARNERIN & TROVICI LLP
TEL. (617) 542-2290
FAX. (617) 451-0313

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species for prosecution on the merits is required, to which the claims shall be restricted if no generic claim is finally held to be allowable. However, the Applicants respectfully submit that the official action fails to indicate sufficient reasons for the above restriction requirement, and therefore the requirement to restrict is improper and should be withdrawn.

Every requirement to restrict has two aspects, namely, the reasons why the inventions as claimed are either independent or distinct, and the reasons for insisting upon restriction therebetween. The Applicant respectfully points out that the official action fails to provide any reasons whatsoever in satisfaction of the above-mentioned first and second aspects of the restriction requirement.

For example, the official action must provide some indication that there would be an extra burden on the Office to examine the separate inventions in a single application (see MPEP § 808). This requirement of demonstrating a burden on the Office is satisfied by one of the following reasons approved by the Commissioner, as set forth in MPEP § 802.02: (1) there is a separate classification of the separate inventions, (2) separate fields of search would be required for the separate inventions,

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WEINGARTEN, SCHURGTN.
GAGNEBIN & LESOVITZ LLP
TEL. (617) 542-2290
FAX. (617) 451-0313

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and (3) the separate inventions have achieved a separate status in the art even though they are classified together.

The Applicants respectfully submit that the official action provides no reasons why examining the separate inventions in a single application would impose an extra burden on the Office. The Applicants further submit that the claimed inventions would not be classified separately, would not require separate fields of search, and have not achieved separate status in the art, and therefore would not impose an extra burden on the Office if examined in the same application.

In view of the foregoing, it is respectfully submitted that the requirement to restrict in the above-reference application is unwarranted and should be withdrawn. Early and favorable action is requested.


The Examiner is encouraged to telephone the undersigned Attorney to discuss any matter that would expedite allowance of

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the present application.

Respectfully submitted,

NAIMISH PATEL, ET AL.

By: 
Richard E. Gamache
Registration No. 39,196
Attorney for Applicants

WEINGARTEN, SCHURGIN,
GAGNEBIN & LEOVICI LLP
Ten Post Office Square
Boston, MA 02109
Telephone: (617) 542-2290
Telecopier: (617) 451-0313

REG/pjd
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